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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,624	02/25/2004	Thomas Harr	30471/36574A	3077
4743	7590 08/31/2006		EXAMINER	
	L, GERSTEIN & BOI	GABEL, GAILENE		
233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER			ART UNIT	PAPER NUMBER
CHICAGO,			1641	
			DATE MAILED: 08/31/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

		A				
	Application No.	Applicant(s)				
	10/786,624	HARR ET AL.				
Office Action Summary	Examiner	Art Unit				
	Gailene R. Gabel	1641				
The MAILING DATE of this communic Period for Reply	cation appears on the cover sheet w	ith the correspondence address				
A SHORTENED STATUTORY PERIOD FO WHICHEVER IS LONGER, FROM THE MA - Extensions of time may be available under the provisions or after SIX (6) MONTHS from the mailing date of this commu. - If NO period for reply is specified above, the maximum statu. - Failure to reply within the set or extended period for reply whan y reply received by the Office later than three months after earned patent term adjustment. See 37 CFR 1.704(b).	ILING DATE OF THIS COMMUNI f 37 CFR 1.136(a). In no event, however, may a nication. utory period will apply and will expire SIX (6) MOI will, by statute, cause the application to become A	CATION. reply be timely filed NTHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed	on <u>25 February 2004</u> .					
2a) This action is FINAL . 2b	o) ☐ This action is non-final.					
•	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice	e under <i>Ex parte Quayle</i> , 1935 C.D	D. 11, 453 O.G. 213.				
Disposition of Claims						
4)⊠ Claim(s) <u>9-14, and 17-27</u> is/are pending in the application.						
4a) Of the above claim(s) is/are	4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.	A Later Land Land Land Land					
8)⊠ Claim(s) <u>9-14 and 17-27</u> are subject t	o restriction and/or election require	ement.				
Application Papers						
9)☐ The specification is objected to by the	Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any object						
Replacement drawing sheet(s) including t						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for a) All b) Some * c) None of: 1. Certified copies of the priority d 2. Certified copies of the priority d 3. Copies of the certified copies of application from the Internation * See the attached detailed Office action	ocuments have been received. ocuments have been received in A f the priority documents have beer al Bureau (PCT Rule 17.2(a)).	Application No received in this National Stage				
Attachment(s) 1) Notice of References Cited (PTO-892)	4) ☐ Intendew	Summary (PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PT	O-948) Paper No	s)/Mail Date				
 Information Disclosure Statement(s) (PTO-1449 or P Paper No(s)/Mail Date 	TO/SB/08) 5) Notice of (6) Other:	Informal Patent Application (PTO-152)				

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DETAILED ACTION

Preliminary Amendment

1. Applicant's preliminary amendment is acknowledged and has been entered.

Claims 1-8, 15, and 16 have been cancelled. Claims 26 and 27 have been added.

Accordingly, claims 9-14 and 17-27 are pending.

Election/Restrictions

- 2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 9-14, drawn to vector and cell line transfected by the vector, classified in class 435, subclass 377, for example.
 - II. Claims 17-27, drawn to method of assaying apoptotic or necrotic activity, classified in class 435, subclass 7.23, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the process as claimed can be practiced with another materially different product, i.e. isolated hematopoietic progenitor cells, to determine non-apoptotic activity or proliferation of the cells in response to a test substance.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. Literature search for each method and product is distinct since the structural requirements of each invention are different. While searches would be expected to overlap, there is no reason to expect the searches to be coextensive.

3. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP

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§ 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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- 5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (571) 272-0820. The examiner can normally be reached on Monday, Tuesday, and Thursday, 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Gailene R. Gabel Patent Examiner Art Unit 1641 August 24, 2006